

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

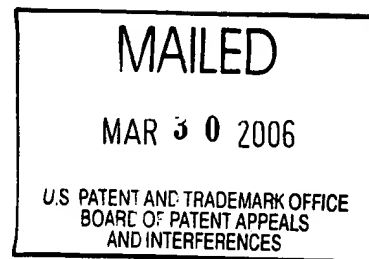
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIRA SUGIYAMA

Appeal No. 2005-1950
Application No. 09/194,051

ON BRIEF¹



Before HAIRSTON, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-39. We do not sustain the rejection of the claims under the judicially created doctrine of obviousness-type double patenting.

¹ In a paper filed February 23, 2006, appellant waived an oral hearing scheduled for March 21, 2006.

BACKGROUND

The invention relates to an authentication data issuing system. Claim 1 is reproduced below.²

1. An authentication-data issuing system based on unique time, said authentication-data issuing system including a plurality of computers connected with each other via communication lines with one of said computers set to function as a master computer, said master computer comprising:

a unique time generating device including time keeping means for sequentially outputting unit time values at predetermined intervals over a preset time-measuring period that begins at a given start point on a selected date and terminates at a given future end point and accumulating means for sequentially accumulating said unit time values output by said time keeping means so as to constantly measure a changing elapsed time within the time-measuring period;

transmitter means for, during communication between said master computer and another of the computers subservient to said master computer, transmitting, from said master computer to the subservient computer, authentication data based on an elapsed time measurement, corresponding to a given time point, indicated by said unique time generating device; and

register means for receiving and registering an issuance history of unique authentication data created and issued by said subservient computer imparting additional data, unique to said subservient computer, to the authentication data transmitted by said master computer.

Claims 1-39 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-7 of the instant inventor's U.S. Patent 5,933,625 ("625 patent") in view of U.S. Patent 5,502,765 ("Ishiguro").

² As noted in our remand of March 25, 2004, instant claims 11, 27, 29, 30, and 31 should be rejected under 35 U.S.C. § 112, fourth paragraph, as failing to further limit the subject matter of the claims from which they depend.

We earlier remanded this proceeding for the examiner to provide a supplemental Answer that set forth a clear statement of the rejection, comparing one application claim to one or more claims in the '625 patent. The examiner mailed a supplemental Answer on June 2, 2004. In accordance with 37 CFR § 1.193(b)(1) (2004), appellant filed a reply brief on August 2, 2004 in response to the supplemental Answer.

OPINION

Obviousness-type double patenting is a judicially created doctrine grounded in public policy, which prevents the extension of the term of the original patent via the patenting of an obvious variation. Under obviousness-type double patenting, a patent is invalid when it is merely an obvious variation of an invention disclosed and claimed in an earlier patent by the same inventor.

Georgia-Pacific Corp. v. United States Gypsum Co., 195 F.3d 1322, 1326, 52 USPQ2d 1590, 1593 (Fed. Cir. 1999) (citations omitted).

A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. Eli Lilly and Co. v. Barr Labs. Inc., 251 F.3d 955, 968, 58 USPQ2d 1869, 1878 (Fed. Cir. 2001).

In the examiner's opinion, as set out in the supplemental Answer, instant claim 1 is not patentably distinct over the claims of the '625 patent, in view of the teachings of Ishiguro, and would thus effect an unjustified extension of the patent term.

Appellant submits that the examiner errs in not showing within the claims of the '625 patent or Ishiguro the claim 1 feature of accumulating means for sequentially

accumulating said unit time values output by said time keeping means "so as to constantly measure a changing elapsed time within the time-measuring period."

We agree with the examiner there is no substantive difference between the accumulating means of instant claim 1 and the accumulating means claimed in the '625 patent. The '625 patent teaches (col. 9, l. 56 - col. 10, l. 3) how accumulating section 5 accumulates time unit time values, so as to constantly provide a changing current elapsed time. Moreover, the instant specification expressly states (in the paragraph bridging pages 2 and 3) that the instant invention uses the unique time generating device of the '625 patent (PCT/JP96/02433), which is described (at spec. page 11) to constantly measure changing elapsed time toward the last second within the present time-measuring period. Further, we compare Figure 2 of the '625 patent with Figure 3 of the instant disclosure, which appellant describes, in the paragraph bridging pages 13 and 14 of the instant specification, as constantly providing a changing elapsed time within the preset time-measuring period.

Appellant also contends that the rejection fails to show transmitter means for transmitting, from a master computer to a subservient computer, authentication data based on an elapsed time measurement. Claim 1 requires transmitting authentication data based on an elapsed time measurement, corresponding to a given time point, indicated by the unique time generating device.

The rejection admits that the '625 patent claims do not recite a "transmission means." The rejection turns to Ishiguro, teaching a method and apparatus for settling

financial accounts via integrated circuit (IC) cards. The examiner submits that Ishiguro teaches a master computer and second or subservient computers with respective transmission means that allow for communication of authentication data between the computers. In particular, the rejection submits that Ishiguro teaches a master (management center) computer that generates a time stamp for authenticating a transition between the IC card and the IC card terminal. The rejection refers to Figures 5 and 10, and material at columns 5, 7, 15, 19, and 20 of Ishiguro for description relating to the "time stamp."

Ishiguro teaches (col. 15, l. 12 - col. 18, l. 2; col. 19, l. 29 - col. 20, l. 29) that IC card terminal 2 (Fig. 10) has a program that executes an algorithm for updating a time stamp. The time stamp in the terminal is independently updated by an internal timer from an initial value. The management center 4 and the system may thereby determine, from the value of the time stamp at the time that an IC card terminal is stolen, that IC cards containing transactions with time stamps subsequent to theft of the IC card terminal are deemed invalid.

The only "authentication" that the rejection references in the '625 patent is in purporting to determine the meaning of providing a "time reference in computers" in the preamble of claims 1 and 5. The rejection refers to a section of the patent's "Summary of the Invention."

It is therefore an object of the present invention to provide a technique which is capable of setting a common or different time concept between a plurality of computers so as to to [sic] achieve a smooth

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network communication between the computers and to also allow the computers to reliably authenticate each other.

'625 patent at col. 2, ll. 50-55.

The '625 patent, throughout its disclosure, teaches that the unique time generating device may be used for authentication of transactions between computers. Moreover, the title of the patent is "Unique Time Generating Device And Authenticating Device Using The Same."

Although the patent disclosure may be used in order to understand the meaning of claim terms, the disclosure may not be used as prior art in the instant inquiry. See In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The rejection does not refer to a definition of a "time reference in computers" in the '625 patent disclosure, but relies on a teaching in the disclosure with respect to an application of the time reference in computers.

Absent the recognition that the claimed time reference of the '625 patent may be used for authentication of transactions between computers, there is no explanation on this record as to why the artisan would have regarded the invention claimed in the '625 patent applicable to the authentication system described by Ishiguro, or the authentication system described by Ishiguro applicable to the invention claimed in the '625 patent.

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Since the evidence that may properly be used in a rejection under the doctrine of obviousness-type double patenting is insufficient to support the ultimate conclusion in the instant case, we cannot sustain the rejection.


CONCLUSION

The rejection of the claims 1-39 under the judicially created doctrine of obviousness-type double patenting is reversed.

REVERSED


KENNETH W. HAIRSTON
Administrative Patent Judge


JOSEPH F. RUGGIERO
Administrative Patent Judge


HOWARD B. BLANKENSHIP
Administrative Patent Judge

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